INDEX

Page

MOTION OF KAWNEER COMPANY, INC. FOR LEAVE TO FILE BRIEF AMICUS CURIAE

BRIEF AMICUS CURIAE OF KAWNEER COMPANY, INC.

Question presented 1

Statement 2

Summary of argument 3

Argument:

I. The common law doctrine of mutuality of estoppel was the sole basis of the holding of Triplett v. Lowell that an adjudication of patent invalidity is not res judicata against the patentee in subsequent litigation against a different defendant 5

II. In cases governed by federal law, lack of mutuality no longer precludes the application of collateral estoppel in situations where the party against whom the estoppel is applied has already had his day in court 9

Conclusion 18

CITATIONS

CASES:

Aghnides v. *Holden*, 226 F.2d 949 (7th Cir. 1955) 14

Automatic Radio Manufacturing Co. v. *Hazeltine Research, Inc.*, 339 U.S. 827 (1950) 18

Bernhard v. *Bank of America*, 19 Cal. 2d 807, 122 P.2d 892 (1942) 9

Blonder-Tongue Laboratories, Inc. v. *University of Illinois Foundation*, 422 F.2d 769 (7th Cir. 1970) .. 3

Blumcraft of Pittsburgh v. *Kawneer Company, Inc.*, 166 U.S.P.Q. 265 (N.D. Ga. 1970) 17

Page

Bruszewski v. *United States*, 181 F.2d 419 (3d Cir. 1950) 12

DeWitt v. *Hall*, 225 N.E.2d 195 (1967) 10

Lear v. *Adkins*, 395 U.S. 653 (1969) 18

Nickerson v. *Kutschera*, 295 F. Supp. 1 (D. Del. 1969).. 15

Nickerson v. *Kutschera*, 390 F.2d 812 (3d Cir. 1968) .. 15

Nickerson v. *Kutschera*, 419 F.2d 983 (3d Cir. 1969) .. 15

Nickerson v. *Pep Boys*, 247 F. Supp. 221 (D. Del. 1965) 6,8

Rachal v. *Hill*, No. 29585, 5th Cir. December 3, 1970 .. 11

Sequros Tepeyac, S. A. v. *Jernigan*, 410 F.2d 718 (5th Cir. 1969) 9

Tampa Phosphate R.R. v. *Seaboard Coastline R.R.*, 418 F.2d 387 (5th Cir. 1969) 10

Technograph Printed Circuits, Ltd. v. *Methode Electronics Inc.*, No. 62 C 1761, N.D. Ill. 16,17

Triplett v. *Lowell*, 297 U.S. 638 (1936) 1,3,5,6,7

United States v. *United Air Lines, Inc.*, 216 F. Supp. 709 (D. Nev. 1962), *aff'd in part*, 335 F.2d 379 (9th Cir. 1964) 13

University of Illinois Foundation v. *Winegard Co.*, 402 F.2d 125 (8th Cir. 1968), *cert. denied*, 394 U.S. 917 (1969) 2

University of Illinois Foundation v. *Winegard Co.*, 271 F. Supp. 412 (S.D. Iowa 1967) 2

Zdanok v. *Glidden*, 327 F.2d 944, 954 (2d Cir. 1964), *cert. denied*, 377 U.S. 934 (1964) 9,11,18

IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 338

BLONDER-TONGUE LABORATORIES, INC., *Petitioner,*

v.

UNIVERSITY OF ILLINOIS FOUNDATION

and

JFD ELECTRONICS CORPORATION, *Respondents.*

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

---

MOTION OF KAWNEER COMPANY, INC. FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Kawneer Company, Inc. hereby respectfully moves for leave to file the attached brief *amicus curiae* in this case. The consent of counsel for the petitioner was requested but refused, necessitating the filing of this motion pursuant to Rule 42.3.

The interest of Kawneer Company, Inc. in this case arises from the fact that it is a defendant in a patent infringement action presently pending in the United States District Court for the Northern District of Georgia. *Blumcraft of Pittsburgh* v. *Kawneer Company, Inc.,* No. 12847, N.D.Ga. That action involves a design patent which has been held invalid by the United States Court of Appeals for the Fourth Circuit in *Blumcraft of Pittsburgh* v. *Citizens and Southern National Bank,* 407 F.2d 557 (4th Cir.), *cert. denied* 395 U.S. 961 (1969). A motion for summary judgment filed by defendants in the Georgia action raises the same question presented in the instant case; namely, whether the holding of *Triplett* v. *Lowell,* 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, should be adhered to.

In the instant case that question was not raised in the petition for certiorari. The Court subsequently requested the parties to address themselves in their briefs and oral arguments to that question. Perhaps unexpectedly, however, the brief for petitioner argues that the holding of *Triplett* v. *Lowell* should be reaffirmed, even though the court below expressed its dissatisfaction with the *Triplett* rule in concluding that respondents were not bound by a prior final judgment holding invalid one of the patents upon which this action against petitioner was based. Respondents will doubtless agree with and attempt to support petitioner's argument on this point.

The brief which *amicus curiae* is requesting permission to file will contain argument urging that the holding of *Triplett* v. *Lowell* should not be adhered to, and

it appears that no such argument will be presented by the parties.

Respectfully submitted,

JOSEPH B. BRENNAN
3100 First National Bank Tower
Atlanta, Georgia 30303

RICHARD D. MASON
20 North Wacker Drive
Chicago, Illinois 60606

BENNETT L. KIGHT
3100 First National Bank Tower
Atlanta, Georgia 30303

Attorneys for Amicus Curiae

Of Counsel:

SUTHERLAND, ASBILL & BRENNAN
3100 First National Bank Tower
Atlanta, Georgia 30303

WILLIAM S. WHITE
WHITE, KLUTE & WHITE
223 Fourth Street
Niles, Michigan 49120

IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 338

BLONDER-TONGUE LABORATORIES, INC., *Petitioner,*

v.

UNIVERSITY OF ILLINOIS FOUNDATION

and

JFD ELECTRONICS CORPORATION, *Respondents.*

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

---

BRIEF AMICUS CURIAE OF KAWNEER COMPANY, INC.

QUESTION PRESENTED

This brief *amicus curiae* is addressed exclusively to the question whether the holding of *Triplett* v. *Lowell,* 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, should be adhered to.

STATEMENT

The principal fact relevant to the question considered in this brief is that United States Patent No. 3,210,767 issued on October 5, 1965 in the name of D. E. Isbell (referred to herein as "the *Isbell* patent"), which the court below held valid and infringed by the petitioner, was determined to be invalid on the ground of obviousness by a final judgment of a district court in Iowa, affirmed by the Eighth Circuit, prior to the entry of judgment in the court below.

The respondent University of Illinois Foundation brought an action in a district court in Iowa against the Winegard Company (referred to herein as "the *Winegard* litigation") alleging infringement of the *Isbell* patent. After a full trial on the merits, the district court held that the *Isbell* patent was invalid on the ground of obviousness. *University of Illinois Foundation* v. *Winegard Co.,* 271 F. Supp. 412 (S.D. Iowa 1967). The Foundation appealed the decision to the Eighth Circuit, which affirmed the judgment of the district court holding the *Isbell* patent invalid, and the Foundation's petition for certiorari was denied. *University of Illinois Foundation* v. *Winegard Co.,* 402 F.2d 125 (8th Cir. 1968), *cert. denied,* 394 U.S. 917, (1969).

After the filing of the complaint in the *Winegard* litigation, the Foundation filed its complaint in the instant case against petitioner Blonder-Tongue Laboratories, Inc. in a district court in Illinois, charging Blonder-Tongue with infringement of the *Isbell* patent and another patent. The respondent JFD Electronics Corporation was made a party, and Blonder-Tongue asserted counterclaims against the respondents which are not relevant to the questions discussed in this brief.

Subsequent to the entry of the district court's judgment in the *Winegard* litigation holding the *Isbell* patent invalid, but prior to the affirmance of that judgment by the Eighth Circuit, the district court in the instant case held that the *Isbell* patent was valid and infringed by Blonder-Tongue. While Blonder-Tongue's appeal to the court below was pending, the judgment in the *Winegard* litigation declaring the *Isbell* patent invalid was affirmed by the Eighth Circuit and certiorari was denied. In its opinion, the court below expressly recognized that the *Isbell* patent had been declared invalid by the final judgment in the *Winegard* litigation, but reluctantly concluded that the holding of *Triplett* v. *Lowell* precluded the application of the principles of res judicata to make that judgment binding upon the Foundation.[1] On the record before it, the court below affirmed the district court's judgment holding that the *Isbell* patent was valid and infringed by Blonder-Tongue. Blonder-Tongue's petition for a writ of certiorari was granted on October 19, 1970.

SUMMARY OF ARGUMENT

The holding of *Triplett* v. *Lowell,* 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata against the patentee in subsequent litigation against a different defendant was based upon the common law doctrine of mutuality of estoppel, which prohibited any litigant from basing a plea of

[1] The court said: "It would seem sound judicial policy that the adjudication of that issue against the Foundation in one action where it was a party would provide a defense in any other action by the Foundation for infringement of the same patent. That, however, is not the law *in this field.*" 422 F.2d at 772 (emphasis added).

res judicata by collateral estoppel on a prior judgment unless the litigant had been either a party or in privity with a party to the action resulting in the prior judgment. The mutuality doctrine has no rational foundation, and in the thirty-four years since *Triplett* v. *Lowell* was decided it has become a dead letter in the federal common law of res judicata, except in the field of patent litigation.

The refusal of the lower courts to extend this salutary development in the federal common law of res judicata to the patent field appears to be based upon the view that in *Triplett* v. *Lowell* this Court intended to create a special rule for the application of the principles of res judicata to patent cases. Such a view is not well founded. Examination of the *Triplett* decision shows that the Court was merely applying the general "rules of the common law applicable to successive litigations concerning the same subject matter." In 1936, the mutuality doctrine was entrenched in the common law of res judicata. Today, that irrational doctrine has been discredited and repudiated. This Court should now extend this sound judicial development in the federal common law of res judicata to the patent field, by refusing to adhere to the holding of *Triplett* v. *Lowell*.

The suggestion is made in the brief for petitioner that this Court should adhere to the holding of *Triplett* v. *Lowell* until the rules of res judicata respecting patent litigation are changed by legislative action. This suggestion is without merit. The common law rules of res judicata are judge-made, not statutory. Those rules are designed to protect the judicial process from the abuse of repetitious litigation over controversies which have been finally resolved by a court

of competent jurisdiction, to the extent that such litigation can be precluded without depriving any litigant of his constitutional right to an opportnuity to be heard in court on any issue affecting his legal interests. The formulation of rules so vitally important to sound judicial administration is plainly not a matter in which this Court should await action by Congress.

A litigant who seeks and obtains a judicial determination of an issue in a forum and against a defendant of his choice should be bound by the outcome of the litigation which he institutes. Sound judicial administration dictates that he be precluded from relitigating an issue again and again by the simple expedient of choosing different defendants for his succession of days in court.

ARGUMENT

I.

THE COMMON LAW DOCTRINE OF MUTUALITY OF ESTOPPEL WAS THE SOLE BASIS OF THE HOLDING OF TRIPLETT v. LOWELL THAT AN ADJUDICATION OF PATENT INVALIDITY IS NOT RES JUDICATA AGAINST THE PATENTEE IN SUBSEQUENT LITIGATION AGAINST A DIFFERENT DEFENDANT.

In *Triplett* v. *Lowell,* 297 U.S. 638 (1936), certiorari was granted for the purpose of resolving "questions as to the scope and effect of the disclaimer statute . . . raised in a suit brought to enjoin infringement of several patent claims, some of which had previously been held invalid in an infringement suit in another circuit against different defendants." 297 U.S. at 639. However, the petitioners there extended their arguments far beyond the limited scope of review granted by the Court and contended that:

> "[I]f any claim of a patent is adjudged invalid no further suit can be maintained upon it, or upon

other claims of the patent without disclaimer of the claims previously held invalid." 297 U.S. at 641-42.

In response to this contention, the Court made the following oft-quoted statement:

"Neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant. While the earlier decision may by comity be given great weight in a later litigation and thus persuade the court to render a like decree, it is not res adjudicata and may not be pleaded as a defense. See Mast, Foos & Co. v. Stover Mfg. Co., 177 U.S. 485, 20 S. Ct. 708, 44 L. Ed. 856; Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 35, 50 S. Ct. 9, 74 L. Ed. 147." 297 U.S. at 642.[2]

---

[2] Actually, the holdings of the *Mast* and *Winters* cases cited by the Court in *Triplett* do not support the holding that a prior adjudication against a different defendant does not preclude a patentee from bringing a second suit on the same patent. The distinguishing factors were clearly stated in *Nickerson* v. *Pep Boys*, 247 F. Supp. 221 (D. Del. 1965):

"Mast held that an adjudication of validity (the converse of the situation in Triplett and at bar) against one defendant does not require a determination of validity in a second suit against a different defendant. This is readily understandable for it would obviously be inequitable to have the defendant in the second suit bound by the validity adjudication in the earlier suit, when he had no opportunity to be heard on the question. See Sutherland Paper Co. v. Grant Paper Box Co., 183 F.2d 926, 936, 86 USPQ 337, 345 cert. denied, 340 U.S. 906, 87 USPQ 432. The situation in the present case, where the patentee has had an opportunity in a prior suit to fully litigate the issue of validity and has suffered an adverse verdict, is far different.

"In Winters the Seventh Circuit Court of Appeals had held a latch patent valid and infringed by one who had used them

The lower federal courts have interpreted the foregoing statement as if it were intended to create a special rule for the application of the principles of res judicata to patent cases, and have therefore reluctantly refused to repudiate the mutuality doctrine in the patent field,[3] despite its repudiation in other cases governed by federal law. Such an interpretation is not well founded. In a subsequent portion of the *Triplett* opinion, the Court expressly indicated that it was simply applying common law principles of res judicata:

> "We conclude that neither *the rules of the common law applicable to successive litigations concerning the same subject matter,* nor the disclaimer statute, precludes relitigation of the validity of a patent claim previously held invalid in a suit against a different defendant." 297 U.S. at 644 (emphasis added).

The specific "rule of the common law" upon which the Court based its holding in *Triplett* was the mutu-

---

The action was defended by counsel employed and paid by the manufacturer of the latches which had sold them to the defendant. Before final judgment was entered the patentee brought a second suit in the Third Circuit against the manufacturer-vendor. The Court of Appeals for the Third Circuit held that the patent was not infringed. Because of the division on the infringement issue in the two circuits, certiorari was granted by the Supreme Court. The adjudication of infringement in the first suit, under settled principles, would have been res judicata in the second, the plaintiff being the same and the defense of the first action having been controlled by the defendant in the second action. However, since there was nothing in the record in the Third Circuit case to raise the issue of estoppel by the prior judgment of infringement, the Supreme Court held that the effect of the decree in the Seventh Circuit was, at most, that which it had under the doctrine of comity." 247 F. Supp. at 221-22.

[3] *See, e.g.,* n. 1, *supra.*

ality doctrine. As the court pointed out in *Nickerson* v. *Pep Boys,* 247 F. Supp. 221 (D. Del. 1965):

> "The view that an adjudication of patent invalidity should not be binding upon a patentee in a second suit against a different defendant, undoubtedly has its roots in the theory that in order for a judgment to prevent relitigation of a point once decided, the estoppel of the judgment must be mutual. Since an adjudication of validity of a patent in one action would not be binding in a second action against a different defendant not in privity with the defendant in the first action, under the mutuality theory it would follow that a patentee in a second action should not be bound by an adjudication of invalidity in an earlier suit." 247 F. Supp. at 222.

Although *Triplett* v. *Lowell* may have accurately reflected the law as it existed in 1936, the mutuality doctrine has been discredited and repudiated since that time, and mutuality of estoppel is no longer a prerequisite to the application of res judicata by collateral estoppel in federal cases outside the field of patent litigation.[4] The "rules of the common law applicable to successive litigations concerning the same subject matter" have changed in this respect since 1936, and it is submitted that there is no sound basis for the assumption that the holding of *Triplett* v. *Lowell* bars the recognition of this development in the field of patent litigation, but permits its application to other cases governed by federal law.

---

[4] *See* cases cited pp. 9-13, *infra.*

II.

IN CASES GOVERNED BY FEDERAL LAW, LACK OF MUTUALITY NO LONGER PRECLUDES THE APPLICATION OF COLLATERAL ESTOPPEL IN SITUATIONS WHERE THE PARTY AGAINST WHOM THE ESTOPPEL IS APPLIED HAS ALREADY HAD HIS DAY IN COURT.

Judge Friendly, writing for the Second Circuit in 1964, stated that the "doctrine of the need for mutuality of estoppels, critized by Bentham over a century ago as destitute of any semblance of reason, and as 'a maxim which one would suppose to have found its way from the gaming table to the bench,' . . . has been much eroded in recent years."[5] Since Justice Traynor's landmark opinion in *Bernhard* v. *Bank of America,* 19 Cal. 2d 807, 122 P.2d 892 (1942), the requirement of strict mutuality of estoppel has been subjected to such universal scholarly criticism and such steady judicial erosion that the Court of Appeals of New York was prompted to announce that "[T]he 'doctrine of mutuality' is a dead letter." *DeWitt* v. *Hall,* 225 N.E.2d 195, 198 (1967).

The Fifth Circuit has rejected the mutuality doctrine in three recent decisions. In *Seguros Tepeyac, S. A.* v. *Jernigan,* 410 F.2d 718 (5th Cir. 1969), a diversity case requiring an *Erie* prediction of how the Texas Supreme Court would rule on the question in the light of current judicial and scholarly opinion, the court concluded that the Texas court would reject the outworn and discredited requirement of mutuality:

> "We note, to begin with, that an increasing number of courts have dispensed with the requirements of identity of the parties or mutuality of estoppel *in situations where the party against*

[5] Zdanok v. Glidden, 327 F.2d 944, 954 (2d Cir. 1964).

> *whom the estoppel is applied has already had his 'day in court.'* United States v. Webber, 3 Cir. 1968, 396 F.2d 381, 385, Ham v. Aetna Life Insurance Company, N.D. Okla. 1968, 283 F. Supp. 153; Musgrave v. Bronx Towing Line, Inc., S.D. N.Y. 1963, 219 F. Supp. 918, 920; Factor v. Pennington Press, Inc., N.D. Ill. 1963, 230 F. Supp. 906; Bernhard v. Bank of America Nat'l Trust & Sav. Ass'n 1942, 19 Cal. 2d 807, 122 P.2d 892. Such estoppel has been applied both 'offensively' and 'defensively.' Cf. United States v. Webber, *supra,* and Bruszewski v. United States, 3 Cir. 1950, 181 F.2d 419, 422, cert. denied, 340 U.S. 865, 71 S.Ct. 87, 95 L.Ed. 2d 632. See also Currie, Mutuality of Collateral Estoppel: Limits of the Bernhard Doctrine, 9 Stan. L. Rev. 281 (1957) and Currie, The Contributions of Robert J. Traynor—Civil Procedure: The Tempest Brews, 53 Calif. L. Rev. 25 (1965)." 410 F.2d at 727 (emphasis added).

Subsequently, in *Tampa Phosphate R.R.* v. *Seaboard Coastline R.R.,* 418 F.2d 387 (5th Cir. 1969), a case controlled by federal law, the Fifth Circuit reaffirmed its opinion that mutuality is not a prerequisite to the application of the doctrine of collateral estoppel under such circumstances:

> "The form the issues may take in a subsequent proceeding is not material to the application of collateral estoppel so long as the issues were in fact determined in the original suit. 'In such cases, it is * * * immaterial that the two actions are based on different grounds, or tried on different theories, or instituted for different purposes, and seek different relief. * * *' American Jurisprudence, Judgments, Section 371; Hyman v. Regenstein, *supra,* at 510. *Cf.* Meyers v. Famous Realty, Inc., *supra;* I.C.C. v. Cowan, *supra.* Complete identity of the parties or mutuality of estop-

pel is also not required *where the party against whom the estoppel is applied has already had his day in court.* Seguros Tepeyac, S. A. Compania Mexicana de Seguros Generales v. Jernigan, 5 Cir. 1969, 410 F.2d 718; United States v. Webber, 3 Cir. 1968, 396 F.2d 381, 385." 418 F.2d at 400 (emphasis added).

Finally, in *Rachal* v. *Hill,* No. 29585, 5th Cir., December 3, 1970, another case governed by federal law, the Fifth Circuit said:

> "The federal rule comports with the modern trend and thus it is clear that the requirements of mutuality need not be met for collateral estoppel to be applied in an action presenting a federal question in the courts of the United States." Slip Opn., p. 5-7 (footnotes omitted).

Other courts of appeals have also rejected the mutuality requirement in cases governed by federal law outside the patent field. In a leading case, *Zdanok* v. *Glidden,* 327 F.2d 944 (2d Cir.), *cert. denied,* 377 U.S. 934 (1964), involving the construction of a collective bargaining contract, Judge Friendly reviewed at length judicial and scholarly opinion on the question, and concluded that the much eroded doctrine of the need for mutuality of estoppel has no rational basis, and should be abandoned in cases governed by federal law. Judge Friendly said:

> "We see no purpose in multiplying citations since it is recognized that the widest breach in the citadel of mutuality was rammed by Justice Traynor's opinion in Bernhard v. Bank of America ....Having explained why 'The criteria for determining who may assert a plea of res judicata differ fundamentally from the criteria for determining against whom a plea of res judicata may be

asserted,' and that there is 'no compelling reason . . . for requiring that the party asserting the plea of res judicata must have been a party, or in privity with a party, to the earlier litigation,' he said:

> "'In determining the validity of a plea of res judicata three questions are pertinent: Was the issued decided in the prior adjudication identical with the one presented in the action in question? Was there a final judgment on the merits? Was the party against whom the plea is asserted a party or in privity with a party to the prior adjudication?'" 327 F.2d at 954-55.

Similarly, the Third Circuit in *Bruszewski* v. *United States,* 181 F.2d 419 (3d Cir. 1950), concluded that the lack of mutuality no longer precludes the application of collateral estoppel. In that case, a longshoreman had suffered a personal injury while working upon a docked ship owned by the United States and serviced by a steamship company. In his first suit against the steamship company, it was decided that the company was not negligent and the ship was seaworthy. Thereafter the longshoreman sued the United States for his injury, predicating his action upon the same allegations of negligence and unseaworthiness asserted in the previous action against the steamship company. The court of appeals affirmed the district court's decision that the judgment in the first action was binding upon the plaintiff. The court said:

> "The countervailing consideration urged here is lack of mutuality of estoppel. In the present suit Bruszewski would not have been permitted to take advantage of any earlier affirmative finding of negligence, had such finding been made in the Isthmian case. For that reason he argues that he should not be bound by a contrary finding in

that case. But a finding of negligence in the Isthmian case would not have been binding against the United States because the United States had no opportunity to contest the issue there. The finding of no negligence on the other hand was made after full opportunty to Bruszewski on his own election to prove the very matter which he now urges a second time. Thus, no unfairness results here from estoppel which is not mutual. In reality the argument of appellant is merely that the application of *res judicata* in this case makes the law asymmetrical. But the achievement of substantial justice rather than symmetry is the measure of the fairness of the rules of *res judicata.*" 181 F.2d at 421.[6]

Despite the widespread agreement reflected in the foregoing authorities that the mutuality doctrine has no rational basis and ought to be abandoned, in patent

---

[6] Numerous other cases outside the field of patent litigation decided by the courts of appeals have adopted the modern rule permitting the application of collateral estoppel notwithstanding a lack of mutuality. In *United States* v. *United Air Lines, Inc.*, 216 F. Supp. 709 (D. Nev. 1962), *aff'd as to collateral estoppel sub nom United Air Lines* v. *Wiener*, 335 F.2d 379 (9th Cir. 1964), the district court rejected the mutuality requirement in a multiple party air accident case, and cited a number of such decisions in the personal injury field:

> "The rule of non-necessity for mutuality has been followed in the Tenth Circuit in People of State of Colorado v. Ohio Casualty Ins. Co. et al. (1956), 232 F.2d 474-477; the First Circuit in Haddad v. Border Express, Inc. (1962), 300 F.2d 885, a personal injury and wrongful death case; the Sixth Circuit in Davis v. McKinnon et al. (1959), 266 F.2d 870, a personal injury case which quoted extensively from Bernhard v. Bank of America, supra; and by the Third Circuit in Gibson v. United States (1954), 211 F.2d 425, a personal injury suit in admiralty. In the Ninth Circuit in Hurley v. Southern California Edison Co. (1950), 183 F.2d 125 at 134, the Court approved the doctrine of Bernhard v. Bank of America, supra, but held it not applicable in that case." 216 F. Supp. at 728.

infringement cases the lower courts have felt constrained by the holding of *Triplett* v. *Lowell* to continue to apply the doctrine. They have done so reluctantly, however, and with frequent criticism and dissent.

The following excerpt from the concurring opinion of Judge Schnackenberg in *Aghnides* v. *Holden,* 226 F.2d 949 (7th Cir. 1955), typifies the criticism lodged against the *Triplett* rule:

> "[The patentee] is entitled under existing law to another day in court where he may relitigate the same issue upon which he lost in the Goodrie case. The law does not require him to justify this indulgence. He is entitled to it because a suit testing the validity of a patent is not a proceeding *in rem* and hence Aghnides may litigate and relitigate again and again the question of validity of his patent as long as he selects a different defendant in each of the infringement suits which he files, thus avoiding the wholesome doctrine of *res adjudicata.* This queer result is one which we are unable to avoid. It is a situation which is particularly abhorrent when considered against the backlog of untried cases which clogs our federal courts. The latter are cases where the litigant asks only for his day in court, not a plurality of days in court as Aghnides is entitled to under the existing law." 226 F.2d at 951.

The Third Circuit, which decided twenty years ago in *Bruszewski* v. *United States, supra,* that the mutuality doctrine no longer had any place in the law of collateral estoppel as applied to federal maritime litigation, recently labored through two appeals on the question in a patent case to finally conclude (by a vote of 2-1) that it was bound by the precedent of *Triplett* not to recognize that enlightened development in the

law of collateral estoppel in patent cases. The first appeal was from a summary judgment granted on the basis of defendant's plea of collateral estoppel, notwithstanding the absence of mutuality. After reviewing the mutuality doctrine, the court indicated its agreement with the proposition that "[A] strict requirement of mutuality should not be continued in the field of patent litigation . . . ." *Nickerson* v. *Kutschera,* 390 F.2d 812, 815 (3d Cir. 1968).

The court remanded the case, however, because the plaintiff claimed that it should be permitted to present new evidence which was not presented in the prior litigation. In remanding, the court said:

> "But in otherwise indicating our general approval of the opinion below we do more than endorse careful and enlightened decisions by the District Courts in our Circuit, we also affirm the general position of this court in Bruszewski v. United States, supra, that a strict rule of mutuality no longer has a proper place in the doctrine of *res judicata.*" 390 F.2d at 815.

Upon remand, the district court concluded that the claimed new evidence did not establish the validity of the patent there involved, and that the evidence could have been presented at the original trial. *Nickerson* v. *Kutschera,* 295 F. Supp. 1 (D. Del. 1969).

On the second appeal, a two-judge majority of the court reversed the judgment of the district court in a *per curiam* opinion, and indicated that it would follow the rule announced in *Triplett* until this Court rules that a determination of the invalidity of a patent does not preclude successive suits upon the same patent against different defendants. *Nickerson* v. *Kutschera,* 419 F.2d 983 (3d Cir. 1969). In a strong dissent, Chief

Judge Hastie indicated that he would adhere to the view expressed by the court in the first appeal, that:

> "[E]xcept for considerations of unfairness shown in a particular case, a party who as a plaintiff had asserted a claim and had lost should not be heard again on the merits of that claim even in a second suit which he thereafter has instituted against a stranger to the original claim." 419 F.2d at 985.

Trial judges have also criticized and expressed dissatisfaction with the *Triplett* rule. The following excerpts from the transcript of comments by Judge Will made on the hearing of defendants' motion for a stay of the proceedings in *Technograph Printed Circuits, Ltd.* v. *Method Electronics Inc.*, No. 62 C 1761, N.D. Ill., pending this Court's review of the doctrine of *Triplett* v. *Lowell* are illustrative:

> "THE COURT: Let us suppose the Supreme Court were to hold, which it seems to me is quite possible, while that kind of holding is not binding on an alleged infringer since he is entitled to his day in court to present his reasons as to why the patent is invalid even though some other court in a suit involving some other alleged infringer has found it to be valid, that as against the patentee a determination of invalidity is the ball game. I always thought that ought to be the rule, incidentally. I don't see why, any reason why a patent that is declared invalid should be relitigated against other alleged infringers in the hope that some court will end up holding it is valid, when you have got an opportunity to appeal the first declaration of invalidity and get it resolved.
>
> "It is the only situation I know in which you can keep right on going notwithstanding a declaration that what you own is worthless, you can keep right on going attempting to exploit it. Another one of the irrationalities I find in the Patent Office, which I find along with one or two others. . . .

"Plus when you are talking about the invalidity of the patent it doesn't make any sense. If the patent holder has had full opportunity to present all of the contentions in support of the validity of the patent, the trial court found it invalid and an appellate court affirmed the declaration of the finding of invalidity, why should some other trial court start all over again attempting to determine whether it is valid or not.

"I can see where somebody says, well, but we didn't get a fair shot at that patent because we were not in that case and the declaration of validity should not be binding on us because we didn't have a chance to present the reasons why we think the patent is invalid. I can see some reasons why relitigation of a patent which had been declared valid, because in that situation the party who would be adversely affected by the estoppel wasn't present, didn't have a chance to make his case, didn't have his day in court; but the patent holder whose patent has been declared invalid had his day in court, had his chance to make his case. I just don't understand why he should have another chance in another court on another day with another defendant."[7]

---

[7] Judge Will's unreported comments extracted from certified transcript of proceedings on November 9, 1970 in Civil Action No. 62 C 1761, N.D. Ill. Similarly, in *Blumcraft of Pittsburgh* v. *Kawneer Company, Inc.*, 166 U.S.P.Q. 265 (N.D. Ga. 1970), Judge Henderson stated:

"Certainly with the heavy caseload in this district, it would be preferable not to have to relitigate the validity of the patent, which has been declared invalid by a circuit court, simply because a plaintiff-patentee later sues defendants not parties to the earlier action. As indicated by defendants, an impressive body of respected legal scholars have urged the solution to this problem is to apply the doctrine of res judicata, eliminating from this doctrine the requirements of mutuality.

"However, the issue raised by defendants' motion for summary judgment is not a new one. Past authority compels that defendants' motion be denied." 166 U.S.P.Q. at 266.

It is submitted that no logical reason supports the distinction which has been drawn between patent cases and other cases with respect to the continuing validity of the doctrine of mutuality of estoppel. In the years since *Triplett* was decided, the mutuality doctrine has been discredited by the lower federal courts in decisions which would be just as much in conflict with *Triplett* as a decision in a patent case rejecting that doctrine would be. It is perfectly clear that in *Triplett* the Court was merely expressing the general "rules of the common law applicable to successive litigations concerning the same subject matter" as they existed in 1936. At the time *Triplett* was decided, the doctrine of mutuality of estoppel was entrenched in the common law principles of res judicata. As Judge Friendly stated when holding the doctrine unsound in *Zdanok* v. *Glidden* in 1964, "We recognize that such a holding would have seemed impossible fifty years ago." 327 F.2d at 954. Today, however, as the authorities discussed above demonstrate, the doctrine of mutuality is a dead letter in all other cases governed by federal law, and this Court should now recognize that development in the field of patent litigation.[8]

CONCLUSION

For the reasons stated it is respectfully submitted that the holding of *Triplett* v. *Lowell* that a determination of patent invalidity is not res judicata as against

[8] That the judge-made rules of law applicable to patent controversies are equally as subject to continuing re-examination and change as those in any other area is well illustrated by the recent decision of this Court in *Lear* v. *Adkins*, 395 U.S. 653 (1969), in which the rule that a patent licensee may not challenge the validity of the licensed patent, established a mere 20 years ago in *Automatic Radio Manufacturing Co.* v. *Hazeltine Research, Inc.*, 339 U.S. 827 (1950), was expressly overruled.

the patentee in subsequent litigation against a different defendant should no longer be adhered to.

Respectfully submitted,

JOSEPH B. BRENNAN
3100 First National Bank Tower
Atlanta, Georgia 30303

RICHARD D. MASON
20 North Wacker Drive
Chicago, Illinois 60606

BENNETT L. KIGHT
3100 First National Bank Tower
Atlanta, Georgia 30303

Attorneys for Amicus Curiae

Of Counsel:

SUTHERLAND, ASBILL & BRENNAN
3100 First National Bank Tower
Atlanta, Georgia

WILLIAM S. WHITE
WHITE, KLUTE & WHITE
223 Fourth Street
Niles, Michigan 49120